

Remarks

I. Introduction

This is in response to the Office Action dated November 26, 2008.

The Office Action objected to claims 3 and 4 for informalities because claims 3 and 4 were identical to one another. In response, claim 4 has been canceled.

The Office Action rejected claim 27 under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Office Action rejected claims 1-8, 12, and 17-23 under 35 U.S.C. §102(b) as being anticipated by Jones et al. (WO 0035238 A) ("Jones"), as applied in a related International Search Report.

The Office Action rejected claims 1-29 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 6,925,158 to McNutt ("McNutt").

The Office Action rejected claims 9-11 and 13-16 under 35 U.S.C. §103(a) as being unpatentable over Jones, as applied in the International Search Report. The Office Action rejected claims 13 and 15 under 35 U.S.C. §103(a) as being unpatentable over Gaw et al. (WO 9853581 A) ("Gaw"), as applied in the International Search Report. The Office Action rejected claims 9-11 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,101,182 to Sistanizadeh et al. ("Sistanizadeh"), as applied in the International Search Report. The Office Action rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,324,681 to Erickson et al. ("Erickson"), as applied in the International Search Report. The Office Action rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over *Simple Object Access Protocol 1.1*, November 2002, as applied in the International Search Report.

Claim 27 has been amended. Claim 4 has been canceled. Claims 1-3 and 5-29 are pending.

II. Rejection under 35 U.S.C. §101

Independent claim 27 was rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular the Office Action states, “[t]he term ‘wizard’ in this claim is used vaguely and can be defined as ‘software adaptable to guide a user through predetermined sequential steps of a task’ as found in the specification. Claims directed to software that are not embodied on a statutory physical computer readable media are not patentable.” In response Applicants point out that the independent claim 27 recites that limitations of “an input processor...” and “an output processor...,” which clearly show that claim 27 is directed to a machine. In order to expedite prosecution, Applicants have amended independent claim 27 to recite “[a]n apparatus for providing a wizard adaptable to configure a network interface device couplable to a programmable logic controller, said apparatus comprising...,” in order to clarify that claim 27 is directed to a machine. Therefore, withdrawal of the rejection of independent claim 27 under 35 U.S.C. §101 is respectfully requested.

III. Rejections under 35 U.S.C. §102(b)

Independent claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by Jones. Independent claims 1, 27, 28, and 29 were rejected under 35 U.S.C. §102(b) as being anticipated by McNutt. In order for a claim to be anticipated under 35 U.S.C. §102, **each and every** limitation of the claim must be found either expressly or inherently in a single prior art reference. PIN/NIP, Inc. v. Platte Chem. Co., 304 F.3d 1235, 1243 (Fed. Cir. 2002). In the present case, Jones does not show each and every limitation of independent claim 1, and McNutt does not show every limitation of independent claims 1, 27, 28, and 29. Therefore, applicants request the withdrawal of the rejections under 35 U.S.C. §102(b).

The present invention generally relates to configuring a network interface device. As illustrated in FIG. 1, a network interface device 1200 can be used to communicatively couple a process network 1400 related to an industrial application to a non-process

network 1300, such as an Ethernet network, UDP-based network, TCP-based network, or the Internet. As described at paragraphs [80]-[83] of the specification, a wizard 1600 automatically enforces user compliance with a plurality of predetermined steps for a computer-assisted configuration of the network interface device. As described in paragraph [91], the computer-assisted configuration layer can relate to an OSI transport layer or any layer above the transport layer in the OSI model.

Independent claims 1, 27, 28, and 29 claims the above described aspects. In particular, independent claim 1 recites “automatically enforcing, via a wizard, user compliance with a plurality of predetermined steps for a computer-assisted configuration of the network interface device, the computer-assisted configuration relating to an OSI transport layer or above.” Independent claim 27 recites “an input processor adapted to sequentially prompt a user for at least one setting for configuring the network interface device at an OSI transport layer or above.” Independent claim 28 recites “a wizard comprising a plurality of predetermined steps adapted to configure said network interface device at an OSI transport layer or above.” Independent claim 29 recites “providing a plurality of predetermined steps adapted to sequentially prompt a user for at least one setting for configuring the network interface device at an OSI transport layer or above.”

Jones does not disclose this limitation of independent claim 1, and therefore does not anticipate claim 1 under the strict anticipation standard of §102. McNutt does not disclose these limitations of independent claims 1, 27, 28, and 29, and therefore does not anticipate claims 1, 27, 28, and 29 under the strict anticipation standard of §102.

Jones is directed to a uniform resource locator (URL) that includes an identifier part, a service parameter part and an address part. The identifier part identifies the URL as being for a resource on a circuit-switched network. A terminal reads the address part and the service part of the URL and establishes a connection to the resource. As described at page 4, lines 2-5, the connection can be established by initiating a switched virtual circuit (SVC). Parameters of the switched virtual circuit are determined by the values of the service parameters of the URL. At page 4, lines 5-9, Jones describes an ATM GUI that allows a user to enter options for user-defined settings. However, these

user-defined settings entered using the ATM GUI are parameters of the switched virtual circuit, not parameters of a **network interface device**. Furthermore, the ATM GUI allows users to enter values in boxes, but there is no description in Jones of the ATM GUI enforcing user compliance with a plurality of steps to configure the switched virtual circuit. Therefore, Jones does not disclose “automatically enforcing, via a wizard, user compliance with a plurality of predetermined steps for a computer-assisted configuration of the network interface device, the computer-assisted configuration relating to an OSI transport layer or above,” as recited in independent claim 1.

Thus, Jones does not disclose each limitation of independent claim 1, and claim 1 is allowable over Jones. Since claims 2-3 and 5-26 depend from independent claim 1, these claims are also allowable over Jones.

McNutt generally relates to a modem adapted to be integrated into a programmable logic controller and adapted to facilitate communications with a main processor of the programmable logic controller via a communications medium. The Office Action asserts that column 4, lines 7-33 and column 5, lines 1-3 of McNutt disclose “automatically enforcing, via a wizard, user compliance with a plurality of predetermined steps for a computer-assisted configuration of the network interface device, the computer-assisted configuration relating to an OSI transport layer or above”. At column 4, lines 7-33, McNutt describes operation of a modem integral to a PLC. This section describes the modem receiving a message specification, reading the message specification, determining a device to attempt to access, identifying data variables in the message specification, obtaining, formatting, and placing data values into a message, applying one or more message configurations to the message, and transmitting the message via a communication network. Applicants respectfully point out that lines 18-24 of column 7 describe configuration of the message sent by the modem, not configuration of the modem itself. At column 5, lines 1-3, McNutt states that “[t]he PLC programming tool can provide a software wizard to help set up a remote modem or a modem module for connecting a local PLC to a remote device.” However, McNutt does not specifically describe that the wizard automatically enforces user compliance with a plurality of predetermined steps for a computer assisted configuration of the modem. Further

McNutt does not specifically describe that the wizard performs computer-assisted configuration relating to an OSI transport layer or above of the modem. Therefore, McNutt does not disclose “automatically enforcing, via a wizard, user compliance with a plurality of predetermined steps for a computer-assisted configuration of the network interface device, the computer-assisted configuration relating to an OSI transport layer or above,” as recited in independent claim 1.

For similar reasons to those described in connection with independent claim 1, McNutt does not disclose “an input processor adapted to sequentially prompt a user for at least one setting for configuring the network interface device at an OSI transport layer or above,” as recited in independent claim 27, “a wizard comprising a plurality of predetermined steps adapted to configure said network interface device at an OSI transport layer or above,” as recited in independent claim 28, and “providing a plurality of predetermined steps adapted to sequentially prompt a user for at least one setting for configuring the network interface device at an OSI transport layer or above,” as recited in independent claim 29.

Since McNutt does not disclose each limitation of independent claims 1, 27, 28, and 29, McNutt cannot anticipate claims 1, 27, 28, and 29 under the strict anticipation standard of §102. Therefore, independent claims 1, 27, 28, and 29 are allowable over McNutt. Dependent claims 2-3 and 5-26 depend from allowable independent claim 1, and are therefore also allowable.

IV. Rejections under 35 U.S.C. §103(a)

The Office Action rejected claims 9-11 and 13-16 under 35 U.S.C. §103(a) as being unpatentable over Jones, as applied in the International Search Report. The Office Action rejected claims 13 and 15 under 35 U.S.C. §103(a) as being unpatentable over Gaw et al. (WO 9853581 A) (“Gaw”), as applied in the International Search Report. The Office Action rejected claims 9-11 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,101,182 to Sistanizadeh et al. (“Sistanizadeh”), as applied in

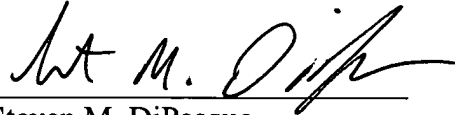
the International Search Report. The Office Action rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,324,681 to Erickson et al. ("Erickson"), as applied in the International Search Report. The Office Action rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over *Simple Object Access Protocol 1.1*, November 2002, as applied in the International Search Report.

In each of these rejections, neither the International Search Report nor the Office Action provided any explanation of which limitations of the claims are shown or not shown in the cited art, and why the limitations lacking in the cited art can be considered obvious under 35 U.S.C. §103. The Office Action does not present a *prime facie* case of obviousness, but merely presents conclusory statements that the claims are unpatentable under 35 U.S.C. §103. "[R]ejections based on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR International Co. v. Teleflex Inc., 550 U.S. 398 (2007) (*see also* MPEP §2143.01). Therefore, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103(a).

V. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "St M. DiPasquo", written over a horizontal line.

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